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09/839,735	04/20/2001	Gregg Freishtat	P3984	3037

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CENTRAL COAST PATENT AGENCY
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EXAMINER

SUAZO, RAINIER A

ART UNIT PAPER NUMBER

2144

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,735

Applicant(s)

FREISHTAT ET AL.

Examiner

Rainier Suazo

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-31 are pending in this application.

Claim Rejections - 35 USC § 102(e)

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-14, 16-21, 23-25 and 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Freishtat et al. (U.S. 6,317,783), hereinafter 'Freishtat'.

Regarding claims 1-11 and 16-18, Freishtat taught a personal information collection and delivery system and method, comprising; a **collection** component executed by a first enterprise, for collecting information for specific individuals from a plurality of information **provider's sites**; an aggregation component executed by the first enterprise, for aggregating and storing the **collected** information identified for individual ones **of the specific individuals**; and a plurality of delivery components executed by a like plurality of second enterprises, for delivering said **aggregated** information to the specific individuals; characterized in that delivery is distinguished to individual ones of the second enterprises (**Abstract, Fig.2, column 3 lines 4-11, 30-33 and column 4**

Art Unit: 2144

lines 26-29, 43-46). Freishtat further taught a system wherein a first organization (enterprise) **collects, aggregates and store data to be presented by a second enterprise in a suitable manner (Fig. 5-6 and column 5 lines 32-55)**

Freishtat further taught a system wherein the system is implemented in the Internet network, and **delivery is accomplished following software routines** prepared for individual ones of the second enterprises **(Fig.8, column 2 lines 46-63, column 4 lines 29-43 and column 7 lines 29-34);** and wherein **delivery is accomplished** by individual ones of the second enterprises **via one or more of wireless networks to one or more wireless appliances, or by cable to cable-ready set-top-boxes or television appliances (column 9 lines 11-15);** and wherein the **information collected and delivered is personal information** requiring secure identification of the specific individuals to the information provider's sites **(from column 6 line 67 to column 7 line 25).**

Regarding claims **12-14 and 19-21,** Freishtat further taught the system wherein the information collected and delivered is personal information requiring secure identification of the specific individuals to the information provider's sites **(column 6 lines 34-54 and column 8 lines 34-61);** and wherein individual information providers limit access to aggregated information according to variables including the origination site used by a specific individual requesting information; and wherein individual ones of the second enterprises provide transaction services to individual ones of the specific

Art Unit: 2144

individuals connecting to the individual ones of the second enterprises through the system; and wherein the transaction services include a user interface enabling a specific individual to access an account and transfer funds from the account for payment to a third party (**Fig. 11 and column 14 lines 16-58**).

Regarding claims **23, 27 and 28**, Freishtat further taught a personal information and transaction system, comprising: a collection component executed by a first enterprise, for collecting information for specific individuals from a plurality of second enterprises as information providers; an aggregation component executed by the first enterprise, for aggregating and storing the collected information identified for individual ones of the specific individuals (**Abstract, Fig.2, column 3 lines 4-11, 30-33 and column 4 lines 26-29, 43-46**), and a plurality of transaction components distinguished to individual ones of the second enterprises, for enabling transactions to be managed by individual ones of the specific individuals (**Fig. 11 and column 14 lines 16-24**); characterized in that the individual ones of the second enterprises publish transaction protocols to the first enterprise, which then provides transaction protocol to the individual ones of the specific individuals, allowing transactions at the second enterprises to be managed by the specific individuals through the system (**column 4 lines 29-32**).

Regarding claims **24 and 29**, Freishtat further taught the use of the Internet network (**Fig.8, column 2 lines 46-63, column 4 lines 29-43 and column 7 lines 29-34**).

Art Unit: 2144

Regarding claims **25 and 30**, Freishtat further taught inclusion of payment and transaction services (**Fig. 11 and column 14 lines 16-24**).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims **1-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Willis, Jr. et al. (**U.S. 6,738,815 B1**) hereinafter 'Willis' in view of Dent et al. (**U.S. 6,128,603**) hereinafter 'Dent' and further in view of Tanaka (**JP 2000235514 A**) hereinafter 'Tanaka'.

-2, -6 -10 -24 -29

Regarding claims **1, 5, 9, 16, 27, 29 and 31**, Willis taught a personal information collection and delivery system and method, comprising; a collection component executed by a first enterprise, for collecting information for specific individuals from a plurality of information systems (**claim 1** ['...retrieve...'], **column 2 lines 42-45 and in column 14 lines 5-10** [the logging process is inherently associate with the differentiation between users]); an aggregation component executed by the information systems (**column 15 lines 14-16** ['...collects...'; note that collect herein refers to accumulate]), for aggregating and storing the collected information identified

Art Unit: 2144

for individual ones of the specific individuals (**column 15 lines 14-16** [note that collecting data and formatting it inherently disclosed storing the data in a computer readable storage medium]); and characterizing the delivery of data distinguishing between individuals (**Abstract, column 14 lines 40-67 and column 15 lines 13-15**).

Willis taught the invention substantially as claimed, however, Willis did not explicitly teach the system wherein there is interaction between providers' sites and different enterprises. However it is suggested in **column 2 lines 35-36, column 5 lines 7-13 and column 12 lines 18-19**. In particular in column 12, lines 18-19 motivates the exploration of the art of multiple servers interaction.

Dent taught the interaction with "billers" and "billers computing units" commensurate with second enterprises (**column 4 lines 40-49**). Dent further taught a plurality of delivery components executed by a like plurality of second enterprises, for delivering said aggregated information to the specific individuals (**column 1 lines 19-26, column 3 lines 1-15, column 4 lines 40-49 and column 5 lines 4-12**). Note that in Dent the biller, which is commensurate with the second enterprise presents the bills.

Takana taught the information retrieval by one server that later forwards the information to another server (**abstract**).

Willis taught implementation of networks using TCP/IP (**Fig. 1 and column 7 lines 21-29**), which motivates the exploration of the art accordingly to implement the invention in expanded networking environments. In addition to, Willis taught systems encompassing billing and payment (**column 2 lines 19-23**), which motivates to explore the art regarding such topics. Willis taught systems encompassing billing and payment transactions (**column 2 lines 19-23**), which motivates to explore the art regarding such topics.

It would have been obvious to one of ordinary skill in the art working with Willis at the time the invention was made to modify the methods and systems of Willis with the teachings of Dent, motivated by Willis to explore of the art of multiple servers interaction (**Willis: column 12, lines 18-19**) and to explore the art of interacting with other enterprises as a service provider (**Willis: column 5 lines 7-13**), in order to obtain a system that expressly interact with a second enterprise and instead of retrieving data from a single enterprise, obtain such data from a second enterprise or site ("biller") (**Dent: column 4 lines 40-49**). It would have been further obvious to one of ordinary skill in the art working with Willis modified by Dent at the time the invention was made to modify the methods and systems of Willis modified by Dent with the teachings of Takana, motivated by Willis to explore of the art of multiple servers interaction (**Willis: column 12, lines 18-19**), in order to obtain a system that expressly extract data and later forwards it to a another server (**Takana: Abstract**) wherein such another server is located in a second enterprise as taught by Dent (**column 11 lines 27-33 and in**

Art Unit: 2144

column 5 lines 4-12). *Willis modified by Dent and Takana, taught obtaining information a first enterprise obtaining (and scrapping) the information from a legacy system (Willis: Claims 1 and 2); said information being information being extracted and returned from and to other servers (Takana: Abstract) and said servers being within the boundaries of a separate enterprise which formats the information in a suitable manner and send it to the specific users of the second enterprise by means of a plurality of delivery components (Dent: column 4 lines 40-58).*

Note that the combination presented herein is an illustration of techniques well known in the art at the time of the invention that would have benefited Willis disclosure opening it to the interaction between enterprises now known as B2B or the interaction with customers now known as B2C, both inside e-commerce outburst created by the Internet that would inherently describe interaction between two or more enterprises. Servers' interaction was also well known and would have benefited Willis in, for example, distributing the load. Moreover, the presentation of the data by the second enterprise is a desirable result obtained by the combination, since enterprises want their customers to perceive that the services are being provided by the enterprise as an added value.

Willis modified by Dent and Takana is hereinafter referenced to as **'the combination'**.

Art Unit: 2144

Regarding particular limitations of claims **2, 6, 10, 17 and 29, the combination** further taught systems and/or methods wherein the system is implemented in the Internet network (**Dent: Fig. 1 and column 4 line 43**) and the systems/methods wherein the information collected and delivered is personal information (**Dent: Abstract ["consumer based"], column 2 lines 24-26 and claim 1 line 5**). The combination further taught delivery of data accomplished following software routines prepared for individual ones of the second enterprises (**Dent: column 4 lines 50-58, Fig. 5, and column 5 lines 7-14**).

Regarding particular limitations of claims **3, and 7, the combination** further taught a systems wherein delivery is accomplished by individual ones of the second enterprises via one or more of wireless networks to one or more wireless appliances (**Willis: Fig. 8 and column 3 lines 42-48**), or by cable to cable-ready set-top-boxes or television appliances.

Regarding particular limitations of claims **4, 8, 11 and 18, the combination** further taught a systems wherein delivery requires secure identification of the specific individuals to the information provider's sites (**Willis: column 6 lines 51-56 and column 16 lines 3-6**).

Regarding particular limitations of claims **12 and 19, the combination** further taught a system wherein access is limited according to variables (**Willis: column 14 lines 51-53, column 16 lines 3-6 column 7 lines 27-29 and column 8 lines 7-15**).

Regarding particular limitations of claim **28, the combination** further comprising a step wherein the transaction components are published to the first enterprise by the commercial institutions (**Willis: column 14 lines 59-60**).

Regarding claim **29, the combination** further taught transactions managed through Internet interactions of individuals and the second enterprise (**Dent: column 6 lines 57-66**). Regarding the limitation that the Internet interaction through sites of the first enterprise it is noted that ISP are considered a separate enterprise and individuals will necessarily access the Internet through the sites of such separate enterprise, thus providing Internet interaction through a separate enterprise is not a novel feature, but rather the typical way to access any website by any common internet user; **the combination** further taught systems and/or methods wherein the system is implemented in the Internet network (**Dent: Fig. 1 and column 4 line 43, Abstract, column 2 lines 24-26 and claim 1 line 5, column 4 lines 50-58, Fig. 5, and column 5 lines 7-14**).

Regarding particular limitations of claims **13, 14, 20, 21 and 30, the combination** further taught the system/method wherein individual ones of the second enterprises

Art Unit: 2144

provide transaction services to individual ones of the specific individuals connecting to individual ones of the second enterprises through the system (**Dent: column 4 lines 59-62**). Examiner appreciates that Dent disclosed the invention in a billing environment wherein providing products or services and critical step before or after the billing. **The combination further** taught systems and/or methods wherein the system/method wherein such system/method enables the transactions to be performed by individuals ones of the specific individuals and including payment processing for payment to a third party (**Dent: claims 9 and 22; column 5 lines 52-63, column 12 lines 50-55 and column 14 lines 15-23**).

Regarding particular limitations of claims **15, 22 and 31**, **the combination** further taught the drag-and-drop implementation for fund transfers (**Dent: claims 9 and 22 in column 12 lines 50-55 and column 14 lines 20-23**).

Regarding claims **23**, **the combination** taught the claimed invention for the same reasons noted above in reference to claim 1, and further taught particularities of a system characterized in that the individual ones of the second enterprises publish transaction protocols to the first enterprise, which then provides transaction protocol to the individual ones of the specific individuals allowing transactions at the second enterprises to be managed by the specific individuals through the system (**Willis: column 6 lines 51-56**), furthermore, in **Dent** taught transactions being managed by specific individuals in **column 5 lines 52-63** and the publications of transaction

Art Unit: 2144

protocols that need to be known by both parties in order to communicate and see the statements as described in **column 6 lines 57-66**.

Regarding claim **24**, **the combination** further taught transactions managed through Internet interactions of individuals and the second enterprise (**Dent: column 6 lines 57-66**). Regarding the limitation that the Internet interaction through sites of the first enterprise it is noted that ISP are considered a separate enterprise and individuals will necessarily access the Internet through the sites of such separate enterprise, thus providing Internet interaction through a separate enterprise is not a novel feature, but rather the typical way to access any website by any common internet user; **the combination** further taught systems and/or methods wherein the system is implemented in the Internet network (**Dent: Fig. 1 and column 4 line 43**) and the systems/methods wherein the information collected and delivered is personal information (**Dent: Abstract ["consumer based"], column 2 lines 24-26 and claim 1 line 5**). **The combination** further taught delivery of data accomplished following software routines prepared for individual ones of the second enterprises (**Dent: column 4 lines 50-58, Fig. 5, and column 5 lines 7-14**).

Regarding claim **25**, **the combination** further taught transaction services including a user interface enabling a specific individual to access an account and transfer funds from the account for payment to a third party (**column 12 lines 50-55, column 14 lines 20-23, claims 9 and 22; column 5 lines 52-63, column 6 lines 58-66 and column 4**

Art Unit: 2144

lines 59-62); the combination further taught the system/method wherein individual ones of the second enterprises provide transaction services to individual ones of the specific individuals connecting to individual ones of the second enterprises though the system (**Dent: column 4 lines 59-62**). Examiner appreciates that Dent disclosed the invention in a billing environment wherein providing products or services and critical step before or after the billing. **The combination further** taught systems and/or methods wherein the system/method wherein such system/method enables the transactions to be performed by individuals ones of the specific individuals and including payment processing for payment to a third party (**Dent: claims 9 and 22; column 5 lines 52-63, column 12 lines 50-55 and column 14 lines 15-23**).

Regarding particular limitations of claims 26, **the combination** further taught the drag-and-drop implementation for fund transfers (**Dent: claims 9 and 22 in column 12 lines 50-55 and column 14 lines 20-23**).

Response to Argument

35 U.S.C. 112 rejection of claim 23 is withdrawn as being properly amended and addressed in Applicants response in **page 14** of the remarks.

Examiner objection to the specification is withdrawn as being properly addressed in Applicants response in **page 14** of the remarks, paragraph 5 and with amendments of record.

Regarding Applicant's arguments presented in **page 15** of the remarks; Applicant states the prior art (**US 6,317,783**) relied upon for rejections under 35 U.S.C. 102(e) shall be disqualified, since the reference and the instant application were commonly owned by the same party at the time of the invention. Examiner noticed that such statements **fail to present facts** regarding who was the owner of the reference and the instant application at the time of the invention; and the date on which such ownership was gained or executed. Examiner further noticed that the instant application has no assignee and the listed inventors are Gregg Freishtat and Vikas Rijsinghani; while in the reference noted above (**US 6,317,783**) the assigned is Verticalone Corporation and the listed are inventors Gregg Freishtat and Palaniswamy Rajan; **therefore the evidence of record demonstrate different inventive entities at the time of the invention.** As a consequence of the discussion in this paragraph, Examiner finds Applicant's statements to insufficient to overcome the rejections under 35 U.S.C. 102(e), therefore rejections under 35 U.S.C. 102(e) are maintained.

Applicant is advised to present facts/evidence regarding who was the owner of the reference and the instant application at the time of the invention; and the date on which such ownership was gained or executed accompanied with a declaration according to Section 1001 of Title 18 of the United States Code and properly executed in accordance with either 37 CFR 1.66 or 1.68.

Regarding Applicants arguments on page 15 regarding the number of claims filed; Examiner points out the original claims, in deed included a claim 31. Examiner further notices that the amended (current) set of claims also included a claim 31.

The additional arguments presented by Applicant have been considered but are moot in view of the new ground(s) of rejection. Applicant is now advised to review the rejection in combination and not singly referring to Willis.

Art Unit: 2144

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rainier Suazo whose telephone number is (571) 272-3931 or (703) 305-3887. The examiner can normally be reached on Monday through Friday, 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (571) 272-3925 or (703) 308-3873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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